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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,521	07/11/2003	Thomas F. Calton	40682/298	5072
33642 7590 03/25/2008 STOEL RIVES LLP - SLC 201 SOUTH MAIN STREET ONE UTAH CENTER SALT LAKE CITY, UT 84111				
EXAMINER				
SWIGER III, JAMES L				
ART UNIT		PAPER NUMBER		
3733				
MAIL DATE		DELIVERY MODE		
03/25/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/618,521

Applicant(s)

CALTON ET AL.

Examiner

JAMES L. SWIGER

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-37 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 4/13/2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Finality

The finality of the previous office action dated 10/16/2007 has been withdrawn.
Claims submitted on 2/19/2008 have been entered and considered for examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-37 rejected under 35 U.S.C. 103(a) as being unpatentable over Insall et al. (US Patent 5,830,216) in view of Mumme et al. (US Patent 5,423,827). Insall et al. discloses a bone preparation/cutting device having a first member that is *configured to be attached* (even indirectly) to bone (70 or 120), a boom (112), and a cutting guide (90). All of these parts may move or pivot in relation to one another because of the attachment knobs (see Fig. 27) and further as claimed, if the second or cut guides are selectively released, each may move with respect to another part of the device depending on the use of the device, as it is adjusted according to various patient anatomy. The reference markers ("0, 3 and 5) shown as angle indicia in Fig. 28) show the device is capable of rotational movement. The device is also capable of translational movement. as the boom can be adjusted (up and down from a front perspective) or could be capable of a proximal/distal motion in relation to the longitudinal axis of the body. The cutting guide itself is also shown as a slit (see Fig. 28).

Insall et al. disclose an adjustable bone preparation device having the claimed structure except for the a first member having a tapering body and the device having protrusions and projections extending between the components for guidance and adjustability. Mumme et al. disclose a tapered, elongate body portion that has a taper that is reduced at the far edges (102/104) compared to the width at the center. This elongated body is connected through adjustable slots (96/98) and the pins 56/58 may be considered protrusions or connecting members that are configured for releasably securing a second member from a first member. Because of the elongate slots, the first and second members can also pivot with respect to one another. Also, the device is capable of having translational movement that is different and separate with respect to the rotational movement (the elongate member moves separately). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Insall et al. having at least the first member having a tapering body and the device having protrusions and projections extending between the components for guidance and adjustability in view of Mumme et al. to have improved adjustability in determining the cut location for resecting bone.

Allowable Subject Matter

The indicated allowability of claims 1-37 is withdrawn in view of the newly discovered reference(s) to Insall et al. '216 in view of Mumme et al. '827. Rejections based on the newly cited reference(s) are above.

Response to Arguments

Applicant's arguments with respect to claims 1-37 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES L. SWIGER whose telephone number is (571)272-5557. The examiner can normally be reached on Monday through Friday, 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3733

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JAMES L SWIGER/
Examiner, Art Unit 3733

/Eduardo C. Robert/

Supervisory Patent Examiner, Art Unit 3733